

DRAFT AMENDMENT

Attorney Docket No. 069769/0115

REISSUE APPLICATION 08/629,547

REMARKS

This is in response to the nonfinal Office Action dated September 3, 1999 (Paper No. 30). Reconsideration and withdrawal of the new rejections and objections raised in the Office Action are respectfully requested.

Response to New Rejections Under 35 U.S.C. 251

Claims 16, 18 and 31 stand rejected under 35 U.S.C. 251 as allegedly being an improper recapture of claimed subject matter canceled in one of the applications for the patent upon which this reissue application is based. This new rejection is respectfully traversed.

The "recapture doctrine" or "recapture rule" is applied to prevent a "patentee from acquiring, through reissue, claims that are of the same or of broader scope than those claims that were cancelled from the original application." *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984). If the reissue claim is narrower than the claim originally presented, then the recapture rule is not a bar. *Id.*

In cases where the reissue claims are broader in some aspects and narrower in other aspects, the Federal Circuit has stated: "[r]eissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule. If a reissue claim is broader in a way that does not attempt to reclaim what was surrendered earlier, the recapture rule may not apply." *Mentor Corporation v. Colorplast*, 998 F.2d 992, 996, 27 USPQ2d 1521 (Fed. Cir. 1993). If added limitations "narrow the claims in any *material aspect* compared with their broadening," then the reissue claim is broader in a way that does not attempt to reclaim what was surrendered earlier, and the recapture rule should not apply. *Id.*

Section 1412.02 of the Manual of Patent Examining Procedure (the "MPEP"), which provides relevant guidelines for the Examiner in considering "recapture" issues under 35 U.S.C. 251, instructs:

Where such [reissue] claims also include some narrowing limitation not present in the claims deliberately canceled in the application, the examiner must determine whether that narrowing limitation has a *material* aspect to it. *If the narrowing limitation has a material aspect to it, then there is no recapture.* However, if the narrowing limitation is incidental, mere verbiage, or would be

DRAFT AMENDMENT

Attorney Docket No. 069769/0115

REISSUE APPLICATION 08/629,547

inherent even if not recited (in view of the specification), then the claims should be rejected under 35 U.S.C. 251. (emphasis added)

Thus, the MPEP clearly instructs that in cases where there is both broadening and narrowing of a reissue claim, one looks to determine whether the narrowing limitation added to the reissue claim is *material*. This is consistent with Federal Circuit precedent in *Mentor*.

Looking at the materiality of the added limitation is also consistent with the instructions of the Federal Circuit and its predecessor court the Court of Customs and Patent Appeals, that "the focus is not [] on the specific limitations or on the elements of the claims but, rather, on the scope of the claims." (emphasis added). *Ball Corporation*, 729 F.2d at 1436. Thus, when reviewing the claims under the recapture doctrine, the reissue claim is examined, as a whole, to determine if the narrowing limitation materially narrows the reissue claim, or if the reissue claim is attempting to reclaim what was surrendered earlier, i.e., a non-material limitation effectively results in a claim that is of the "same scope" as the originally-presented and deliberately canceled claim.

The materiality aspect of the narrowing limitation was stated somewhat differently in *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997). In *Clement*, the Federal Circuit noted that in examining a narrowing limitation, it must be determined if the narrowing limitation is "germane to a prior art rejection," that is, whether the narrowing limitation is "material."¹

¹ In *Clement*, the Federal Circuit provided a specific test which for certain types of reissue claims which are broader in some aspects and narrower in other aspects:

(3) if the reissue claim is broader in some aspects, but narrower in others, then (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

131 F.3d 1464, 1469. As will be discussed below, this test provided in *Clement* does not cover all possible scenarios and does not fit the facts of the present case. Rather, the analysis of *Mentor* is more suited to the present case.

DRAFT AMENDMENT

Attorney Docket No. 069769/0115

REISSUE APPLICATION 08/629,547

Another important principle in determining recapture, is the prohibition against focusing solely on the feature or limitation being removed from the reissue claim. The Federal Circuit has explicitly indicated that it was not adopting this principle applied by some circuit courts of appeals and was instead adopting a more liberal approach taken by the Court of Customs and Patent Appeals. *Ball Corp.*, 729 F.2d at 1435.

The pending reissue claims 16 and 31 are broader in some aspects than claims 1 and 8 of the Applicants' U.S. Patent No. 5,465,635 on which this reissue application is based. Specifically, the pending reissue claims 16 and 31 are broader than claims 1 and 8 of the '635 patent in that they do not include the following limitation:

—wherein each of said elastic plate, said flywheel body and said reinforcing member comprises a first portion, said first portion of said flywheel body being placed axially between said first portions of said elastic plate and said reinforcing member, and said first portions of said elastic plate, said flywheel body and said reinforcing member defining clearances for allowing said first portion of said flywheel body to move axially between said first portions of said elastic plate and said reinforcing member.—

However, reissue claims 16 and 31 are neither broader than nor essentially the same scope as the broadest claim canceled during prosecution of the original '635 patent.

The limitation recited above was added to the claims in the "parent" application Serial No. 08/243,526 to overcome the Examiner's and the Board's earlier prior art rejection based on Numata et al. (Japanese Publication No. 57-058542). Thus, the broader aspects of the pending reissue claims 16 and 31 relate to surrendered subject matter because the limitations removed from the reissue claims were the same limitations added to overcome the prior art rejection based on Numata et al. in the parent application. If this broadening of the reissue claims were the only change from the patent claims, the recapture rule would certainly apply and the claims would be properly rejected under 35 U.S.C. 251, i.e., these hypothetical reissue claims would be of the same scope as the canceled claims in the original prosecution. However, this is not the case.

The reissue claims 16 and 31 are different from the canceled or surrendered claims in the parent and grandparent applications because they include the following narrowing limitation:

—wherein said elastic plate is clamped axially between said reinforcing member and said shaft end of said crankshaft.—

DRAFT AMENDMENT

Attorney Docket No. 069769/0115

REISSUE APPLICATION 08/629,547

This narrowing limitation in the pending reissue claims has been, and apparently still is, considered by the Examiner to patentably distinguish over the Numata et al. reference and the other prior art of record. Thus, there is no question that this narrowing limitation has a material aspect to it, and that the limitation is not incidental, mere verbiage, or inherent in the canceled or surrendered claims. That is, this limitation renders the claim, as a whole, patentable over the prior art. The Applicants are not recapturing the subject matter of a canceled claim, as stated by the Examiner. Instead, the Applicants are presenting the Examiner with a materially narrower claim than the claims canceled or surrendered in the parent and/or grandparent applications, the material narrowness being the limitation noted directly above. The recapture rule does not prohibit such materially narrower claims in this reissue application.

The Examiner stated that the narrowing limitation added to claim 16 "is narrower in another aspect unrelated to the prior art rejection based on Numata et al." Applicants respectfully disagree. The narrowing limitation added to claim 16 is indeed related to the prior art rejection based on Numata et al, and in fact, the limitation being removed and the limitation being added are related to each other. Specifically, the limitation being removed from claims 1 and 8 defines an interrelationship between the elastic plate, the flywheel body and the reinforcing member, relative to the reinforcing member (reference Nos. 2, 5 and 4, respectively, in Figure 1 of the present application). Likewise, the narrowing limitation being added recites an interrelationship between the crankshaft, elastic plate and the reinforcing member, relative to the reinforcing member (reference Nos. 1, 2 and 4, respectively), albeit somewhat more broadly. Thus, this is not the case like *Clement* where the limitations removed in the reissue claims were directed to temperature, mechanical energy and pH limitations and the added limitations were directed to final pulp brightness. Instead, as noted above, the limitations being added are structurally related to the limitations being removed from patent claims 1 and 8. That is, in the words used by the Federal Circuit in *In re Clement*, the narrowing limitation is certainly "germane to a prior art rejection" in that both the narrowing limitation and the removed limitation are structurally related and both overcome the very same prior art rejection being based on Numata et al. 131 F.3d at 1469.

DRAFT AMENDMENT

Attorney Docket No. 069769/0115

REISSUE APPLICATION 08/629,547

Moreover, irrespective of relatedness of the limitations to each other, the narrowing limitations are materially narrower and thus avoid recapture. Without the narrowing limitation, the claims would most certainly have been rejected by the Examiner based on Numata et al. for the same reasons sustained on appeal in the grandparent application. The narrowing limitation is, thus, directly related to this prior art rejection because the limitation makes the claims patentable over the Numata et al. reference, and accordingly, is "material" or "germane to a prior art rejection." Although the narrowing limitation added to the reissue claims 16 and 31 is different in scope from the corresponding limitation found in the patent claims 1 and 8, the limitations are nevertheless similar in that they both distinguish over the Numata et al. reference by reciting a different arrangement of the elastic plate relative to the reinforcing member. A limitation added to a claim to obtain its allowance can be broadened by reissue "if the limitation turns out to be more restrictive than the prior art required." *In re Richman*, 409 F.2d 269, 161 USPQ 359 (CCPA 1969).

Thus, the facts of this case are similar to *Mentor*, yet different in one critical aspect. In *Mentor*, the narrowing limitation was held to "not materially narrow the claim." *Mentor*, 998 F.2d at 996-97. In this instance, the narrowing limitation in claims 16 and 31 has been found to be material, since it renders claims 16 and 31 patentable over Numata et al. Thus, based on the analysis in *Mentor*, the reissue claims do not recapture surrendered subject matter.

The present case is similar to prior court cases in which no violation of the recapture rule was found. For example, in *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984), the reissue claim was narrower than the canceled claims in an aspect relating to a prior art rejection and broader in an aspect unrelated to the rejection. The court allowed the reissue claim because the patentee was not attempting to recapture surrendered subject matter. *Id.* In *Whittaker Corp. v. UNR Industries, Inc.*, 911 F.2d 709, 15 USPQ2d 1742 (Fed. Cir. 1990), the court held that a claim added to a patent during reissue is not invalid under the recapture rule when it contains a limitation making it narrower in scope than a similar claim that was canceled during the original prosecution. Similarly, the Applicants in the present case are presenting claims in this reissue application that are materially narrower in scope than the surrendered

DRAFT AMENDMENT

Attorney Docket No. 069769/0115

REISSUE APPLICATION 08/629,547

claims 16 and 18 in the grandparent application. Thus, the Applicants are not trying to recapture the same claims that were canceled or surrendered during the original prosecution.

The present case is different from the facts of the prior court cases cited by the Examiner in support of the recapture rule. For example, the reissue claims in *In re Clement* were materially broader, and only incidentally narrower, to the claims surrendered during the prosecution. 131 F.3d at 1471, 45 USPQ2d at 1165. The reissue claims in *Clement* were broadened by removing limitations that directly related to several prior art rejections made during the prosecution. *Id.* *Clement*, however, did not add any narrowing limitations having a material aspect that would avoid the prior art rejections and that had not been considered before. The only narrowing limitation in the reissue claim of *Clement* was a limitation that had previously been added in another claim in an effort to overcome a prior art rejection. *Id.* This is much different from the present case where the reissue claims have a materially narrowing limitation related to the limitation removed, not found in any of the surrendered or canceled claims in the parent and/or grandparent applications, that relates to the previous prior art rejection and patentably distinguishes over the Numata et al. reference.

As noted above, the court in *Clement* announced "principles" for reissue claims, which included claims broader in some aspects and narrower in other aspects. *Id.* at 1469. Specifically, the test indicated: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; or (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim. *Id.* In the facts of the present case, part (a) does not apply, because, while being broader in an aspect germane to patentability in that the limitation noted above has been removed, the reissue claim is not narrower in an aspect unrelated to patentability. Instead, the present reissue claims are narrower in an aspect intimately related to patentability and, in fact, to the prior art rejection in the parent cases. Likewise, part (b) does not apply because the reissue claim is broader in an aspect related to patentability by virtue of the removed limitation. Thus, the "principles" *Clement* are not applicable in the analysis of the present facts.

DRAFT AMENDMENT

Attorney Docket No. 069769/0115

REISSUE APPLICATION 08/629,547

The present case is also different from *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472 (Fed. Cir. 1998), in that there has been no showing that any arguments made during the prosecution of the parent and/or grandparent applications were sufficient to trigger the recapture rule. In *Hester*, the court held that surrender of claimed subject matter can occur through arguments alone. 142 F.3d at 1480, 46 USPQ2d at 1648. This holding is not relevant to the present case where the surrendered subject matter identified by the Examiner is found only in the claims that were rejected and appealed in the grandparent application, and not in the Applicants' arguments.

Finally, applying Section 1412.02 of the MPEP quoted in part, above, the narrowing limitation found in the reissue claims 16 and 31 is not "incidental, mere verbiage, or ... inherent" because it has a material aspect to it that is germane to the rejection based on *Numata et al.* and makes the claims patentable over the *Numata et al.* reference. Thus, the MPEP, as well as the prior court cases discussed above, support the Applicants' position that there is no improper recapture in the present case.

Applicants are relying on express precedent from the Court of Appeals for the Federal Circuit and its predecessor court, the CCPA. The cases cited in the Office Action do not (and, in fact, cannot) overrule the prior cases on which Applicants rely. For the reasons explained in detail above, the cases cited in the Office Action do not contain fact situations similar to the present facts, nor do these cases express rules that either contradict the earlier case law or require a finding of reissue recapture in the present case. Finally, the present case is clearly and unequivocally governed by the instructions given to Examiners in the current version of MPEP § 1412.02, and which is based on the *Ball Corp.* and *Clement* cases. It is understood that the Patent Office is bound by the guidelines set forth in the MPEP. *In re Kaghan*, 387 F.2d 398, 156 USPQ 130 (CCPA 1967).

Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejections of claims 16, 28 and 31 based on the recapture rule under 35 U.S.C. 251. It is respectfully submitted that this reissue application is now in condition for allowance. Early issuance of a Notice of Allowance is respectfully requested.

If the Examiner has any questions or comments that could place this application into even better form, he is encouraged to contact the Applicants' undersigned representative at the number listed below.

DRAFT AMENDMENT

Attorney Docket No. 069769/0115

REISSUE APPLICATION 08/629,547

Respectfully submitted,

Dated:

DRAFT

Richard L. Schwaab
Reg. No. 25,479

Foley & Lardner
3000 K Street, N.W., Suite 500
P.O. Box 25696
Washington, D. C. 20007-8696
(202) 672-5300